Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD D. SHINGOLE and GREGORY G. HAFNER

Appeal No. 1998-1433
Application No. 08/241,252

ON BRIEF

Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 through 12, 14 through 30 and 32 through 39, all of the claims remaining in this application. Claims 2, 13 and 31 have been canceled. Subsequent to appellants' filing of their Notice of Appeal (Paper No. 19) and brief (Paper No. 20), the examiner has withdrawn all rejections of the claims on appeal except that of claims 1 and 3 through 11 under 35 U.S.C.

§ 112, first paragraph. In particular, we note the examiner's statement in Paper No. 42, mailed May 16, 2003, that "the only issue remaining on appeal in this application is the 35 U.S.C. § 112 rejection of claims 1 and 3-11." Although the examiner has not indicated that the other claims remaining in the application (i.e., claims 12, 14 through 30 and 32 through 39) are allowed or allowable, no rejection of those claims is before us for review in this appeal.

As noted on page 1 of the specification, appellants' invention relates generally to a method of assembling an apparatus and, more particularly, to a method of assembling fuel injectors. In the paragraph bridging pages 2 and 3 of the specification, appellants briefly describe the invention broadly in the context of "an apparatus" having a plurality of components requiring assembly and wherein the apparatus is of the type including a set of one or more input parameters, a set of one or more control parameters, and a set of one or more observed resultant parameters. Further insight into this broader aspects of appellants' invention may be had by reference to Figure 8 and the description thereof at pages 24 and 25 of the specification, and also to the last paragraph on page 30. The "preferred

embodiment" (specification, page 25) of appellants' method is as applied to a fuel injector (14) and this particular aspect of the invention occupies the bulk of appellants' disclosure. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief (Paper No. 20).

No prior art has been relied upon by the examiner to support the rejection on appeal.

Claims 1 and 3 through 11 stand rejected under 35 U.S.C. § 112, first paragraph, "as the disclosure is enabling only for claims limited to a fuel injector" (final rejection, page 2). Further discussion by the examiner on page 2 of the final rejection urges that

> The specification does not enable a person skilled in the art to which it pertains or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The only disclosure is to a method of assembling a fuel injector. The specification does not provide a disclosure for assembling any other article and therefore is not enabling for other methods.

Rather than reiterate the examiner's further commentary regarding the above-noted § 112 rejection and the conflicting

viewpoints advanced by the examiner and appellants regarding that rejection, we make reference to the examiner's answer (Paper No. 21, mailed September 8, 1997) for the examiner's further reasoning in support of the rejection, and to appellants' brief (Paper No. 20, filed May 12, 1997) and reply brief (Paper No. 22, filed November 10, 1997) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination which follows.

It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See, In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238-39 (CCPA 1971) and In re Scarborough, 500 F.2d 560, 566,

182 USPQ 298, 302-03 (CCPA 1974). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Once this is done, the burden shifts to appellants to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

In the case before us, after reviewing the disclosure as set forth in the specification and the invention as exemplified in drawing Figures 1-10 of the application, and considering the examiner's position in the final rejection and answer, we are of the opinion that the examiner has not met his burden of advancing acceptable reasoning inconsistent with enablement as to claims 1 and 3 through 11 on appeal. While it is true that the claims before us on appeal are far broader than appellants' disclosed preferred embodiment of a fuel injector, this alone is not

sufficient to evidence that appellants have run afoul of the enablement requirement of 35 U.S.C. § 112, first paragraph. This is especially true in a mechanical case such as this, involving predictable arts, where a single disclosed embodiment may provide a basis for broad claims and the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. In re Fischer, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Further in this regard, we note appellants specific disclosure on pages 2, 3, 24 and 25 relating broadly to assembly of "an apparatus" and to the statement on page 30 of the specification that the invention therein can "also be applied to assembling other apparatus or devices, including other types of injectors." Thus, we view the examiner's assertion that the disclosure is enabling only for claims limited to a "fuel injector," to be incorrect.

As for the examiner's belated attempt in the answer to establish "undue experimentation," we are in agreement with appellants' comments and observations in the reply brief (Paper No. 22, pages 1-4). Although appellants' claims on appeal are broadly directed to "[a] method of assembling an apparatus having a plurality of parts" and to an apparatus "of the type including

a set of input parameters, a set of control parameters, and a set of observed resultant parameters," we are of the view that for any given apparatus comprising a plurality of parts, appellants' specification provides adequate guidance for ascertaining a set of input parameters, a set of control parameters, and a set of observed resultant parameters, and for carrying out the disclosed method of assembling the plurality of parts so as to arrive at an apparatus which performs in accordance with its design criteria. In this regard, we note that appellants have characterized their invention as an improvement over a known "select fit process" and indicated on page 18 of the specification that

> Prior art select fit methods of assembly select the component to be assembled, based on its actual dimension, for its capacity to reduce a measured variation from a nominal target dimension, or, as it is sometimes referred to, select fit to nominal. Thus, although both the prior art and the present invention use part or component dimensions in their respective select fit process, prior art methods select fit to compensate only for dimensional variations while the present invention select fits to compensate for performance parameter variations as well as dimensional variations.

We see no reason why one of ordinary skill in the art would need to resort to undue experimentation to incorporate appellants' teaching of compensation for performance parameter variations into the prior art select fit methods relying only on

dimensional variation as the measure of compensation needed to achieve an assembled apparatus which works to its intended design specifications.

After a careful consideration of appellants' disclosure and of the arguments on both sides, it is our opinion that the level of skill in the art is sufficiently high that the ordinarily skilled artisan would have been able to use appellants' method of assembling an apparatus as set forth in claims 1 and 3 through 11 on appeal, based on appellants' originally filed disclosure, without the exercise of undue experimentation. As noted by appellants in the brief (page 5), as a general rule, in a mechanical case such as this, an applicant is entitled to claims, when the art permits, which cover more than the specific embodiment shown. In re Newton, 414 F.2d 1400, 1406, 163 USPQ 34, 39 (CCPA 1969).

For the above reasons, we will not sustain the examiner's rejection of claims 1 and 3 through 11 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner rejecting claims 1 and 3 through 11 is reversed.

REVERSED

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| CHARLES E. FRANKFORT<br>Administrative Patent Judge | ) | |
| JEFFREY V. NASE<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| MURRIEL E. CRAWFORD<br>Administrative Patent Judge | ) | |

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